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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,651	08/07/2001	Kevin P. Headings	108.0010-00000	9189
22882	7590	10/21/2005		
MARTIN & FERRARO, LLP 1557 LAKE O'PINES STREET, NE HARTVILLE, OH 44632			EXAMINER GREENE, DANIEL L	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 10/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,651

Applicant(s)

HEADINGS ET AL.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 41-49 and 60-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 41-49 and 60-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/17/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1, 2, 5, 9, 13, 12, 14, 41, and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In re John Covell Collier, 55CCPA-; 397 F.2d 1003; 158 USPQ 266, Claim-Indefiniteness- Combination- Structural Relationships Between Elements not Positively Recited- 35 U.S.C. 112, second Paragraph. The respective statements in the claims, i.e. "operable to", "available for", and "adapted to" are about intended uses, capabilities, and structures which will result upon the performance of future acts is not a positive structural limitation. The claim does not positively recite structural relationships of the elements in its recitation of what may or may not occur. In this sense it fails to comply with section 112, second paragraph, in failing distinctly to claim what applicant presents as his actual invention.

The main fault is indefiniteness in the sense that things, which may be done, are not required to be done. For example, operable to "combine, maintain, receive, manage, collect, store, grant, etc." have the possibility of happening and are therefore not clear, concise, and concrete actions. These cannot be regarded as structural limitations and therefore not as positive limitations in a claim directed to structure. They cannot therefor be relied on to distinguish from the prior art.

1. The Applicant uses the terminologies, “operable to”, “available for” and “adapted to” as intended uses and capabilities, which will result upon the performance of future acts, as positive limitations. However, the Board has established that in a recitation of what may or may not occur, does not comply with section 112, second paragraph, in failing to distinctly claim what the Applicant describes as his actual invention. Collier, In re, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968) 2163, 2163.05, 2172.01, 2173.05(k)
2. The uses of the terms “operable to”, “available for” and “adapted to” may be done but are not required to be done. Therefore, these cannot be regarded as positive limitations in the claims and cannot be relied on to distinguish from the prior art.
3. **Claim 78** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. The Applicant uses the terminology, “may be used”, as intended use and capability, which will result upon the performance of a future act, as a positive limitation. However, the Board has established that in a recitation of what may or may not occur, does not comply with section 112, second paragraph, in failing to distinctly claim what the Applicant describes as his actual invention. Collier, In re, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968) 2163, 2163.05, 2172.01, 2173.05(k)
5. The use of the term “may be used”, may be done but is not required to be done. Therefore, it cannot be regarded as a positive limitation in the claims and cannot be relied on to distinguish from the prior art.
6. Claims 1-22, 41-49 and 60-87 are pending in the Application.

Information Disclosure Statement

7. The information disclosure statement (IDS) submitted on 8/17/2005 was filed after the mailing date of the Application on 12/14/2000. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

8.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-22, 41-49 and 60-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. U.S. Patent 6,226,618 [Downs], Dorak, Jr. U.S. Patent 6,389,403 [Dorak], and further in view of Swiz et al. U.S. Patent 6,718,551 [Swiz].**

3.

As per claims 1, 41, 60 and 78:

Downs discloses:

a content database for storing the media content offering delivered from said content management system; Col. 8, lines 55-67.

a rack operable to receive the media content offering from said content management system, said rack including a file repository for storing media content associated with the media content offering; Col. 8, lines 55-67. and

a server adapted to distribute media content stored in said file repository. Col. 8, lines 55-67.

a processor operable to combine media assets and metadata. Fig. 1.

Downs discloses the claimed invention except for a content management system having a processor operable to combine media assets and metadata based on selected groupings of the consumers to create a media content offering for each selected grouping of the consumers, said content management system being operable to select the media content offering for distribution to the selected groupings of the consumers based on at least one of a geographical location, a bit rate service, a service provider, and a contractual term and to aggregate the selected media content offering into a rollout available for exhibition to the consumers. However, Downs does teach about data mining, Col. 11, lines 12-15 and broadcasting to customers based upon their preferences and buying habits. Col. 71, lines 25-40, Col. 72, lines 5-18, and Col. 78, lines 20-67. Further, Downs disclose create a media content offering for each selected grouping of the consumers. Fig. 1B.

Swiz teaches that it is known in the art to provide a content management system having a processor operable to combine media assets and metadata based on selected groupings of the consumers to create a media content offering for each selected grouping of the consumers, said content management system being operable to select

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the media content offering for distribution to the selected groupings of the consumers based on at least one of a geographical location, a bit rate service, a service provider, and a contractual term and to aggregate the selected media content offering into a rollout available for exhibition to the consumers. Col. 3, lines 25-65, Col. 4, lines 20-30, Col. 5, lines 1-20, 45-50, Col. 7, lines 15-67, Col. 8, lines 15-25, lines 55-67, Col. 9, lines 1-5, and col. 12, lines 5-12.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the data mining and selecting the type of information to broadcast to their customers of Downs with a content management system having a processor operable to combine media assets and metadata based on selected groupings of the consumers to create a media content offering for each selected grouping of the consumers, said content management system being operable to select the media content offering for distribution to the selected groupings of the consumers based on at least one of a geographical location, a bit rate service, a service provider, and a contractual term and to aggregate the selected media content offering into a rollout available for exhibition to the consumers, of Swiz, in order to target and enhance the content provided to the customer to promote customer loyalty and acceptance.

Downs further disclose:

a subscriber management system for creating a plurality of subscriber accounts, said subscriber management system including at least one processor and at least one medium for storing subscriber account information, said processor being operable to maintain the subscriber accounts and includes a procedure for billing the subscriber

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accounts, said subscriber management system being operable to group individual consumers into the selected groupings for receiving selected media content -offering specific for at least one of the selected groupings. Col. 11, lines 8-15, Col. 34, lines 55-67, Col. 42, lines 35-65.

Downs discloses the claimed invention except for based on selected groupings of the consumers. Dorak teaches that it is known in the art to provide data based on selected groupings of the consumers. Col. 7-8, lines 1-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the Electronic content delivery system of Downs with the distribution based on selected groupings of the consumers of Dorak, in order to provide focused and relevant data to a predisposed consumer.

As per claim 2:

Downs further discloses:

wherein said processor of said subscriber management system is operable to manage consumer-related information, further comprising a database for storing the consumer related information. Col. 10, lines 1-45.

As per claim 3:

Downs further discloses:

wherein the consumer-related information includes billing information. Col. 10, lines 1-45.

As per claim 4:

Downs further discloses:

wherein the consumer-related information includes demographical information. Col. 10, lines 1-45.

As per claims 5 and 70:

Downs further discloses:

wherein said processor of said subscriber management system is operable to collect information associated with the use of media content selected from the media content offering by each consumer. Col. 11, lines 1-29.

As per claim 6:

Downs further discloses:

wherein the content use information includes consumer media content preferences. Col. 24, lines 5-35.

As per claim 7:

Downs further discloses:

wherein the content use information includes an amount of time each consumer uses the selected media content. Col. 52, lines 9-31.

As per claim 8:

Downs further discloses:

wherein the media content offering is programmed to expire after a fixed interval of time. Col. 59, lines 35-67.

As per claim 9:

Downs further discloses:

wherein said content database is adapted to store a plurality of media content offerings to form a composite media content offering. Col. 69, lines 28-67.

As per claims 10, 47, 71 and 86:

Downs further discloses:

wherein said content database is refreshed to change the composition of the composite media content offering. Col. 71, lines 9-35.

As per claims 11, 48, 67, 68, 83 and 84:

Downs further discloses:

wherein said server is a web server, further comprising a video file repository for storing video associated with the media content offering and a video server. Col. 73, lines 12-40.

As per claims 12, 49, 62 and 63:

Downs further discloses:

a licensing server operable to grant a license to each consumer requesting use of selected media content requiring the license upon a determination that the consumer is permitted to use selected media content. Col. 22, lines 25-65.

As per claim 13:

Downs further discloses:

wherein the license includes a decryption key program adapted to decrypt media content that is encrypted. Col. 12, lines 53-67.

As per claims 14 and 61:

Downs further discloses:

wherein said processor is operable to check an accounts database and determine whether the consumer is permitted to use the selected media content. Col. 59, lines 35-55.

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As per claims 15 and 64:

Downs further discloses:

further comprising an ad manager for targeting advertisements to the consumers.

Col. 70, lines 6-35.

As per claims 16 and 65:

Downs further discloses:

wherein the groupings of consumers are arranged based on consumer-related information associated with each consumer of each group. Col. 74, lines 7-65.

As per claims 17, 66 and 74:

Downs further discloses:

wherein the consumer-related information includes demographics of members of each selected group of consumers. Col. 45, lines 29-65.

As per claims 18 and 75:

Downs further discloses:

wherein the consumer-related information includes geographic locations of members of each selected group of consumers. Col. 45, lines 29-65.

As per claim 19:

Downs further discloses:

wherein said content database is located locally to each selected group of consumers. Col. 72, lines 5-45.

As per claim 20:

Downs further discloses:

wherein said file repository and said server are located locally to each selected group of consumers. Col. 72, lines 5-45.

As per claims 21 and 76:

Downs further discloses:

wherein the consumer-related information includes content usage by members of each selected group of consumers. Col. 72, lines 5-45.

As per claims 22 and 77:

Downs further discloses:

wherein the content usage includes viewing habits by members of each selected group of consumers. Col. 72, lines 5-45.

As per claims 42 and 79:

Downs further discloses:

wherein the at least one business rule includes a geographic location of members of each selected group. Col. 71-72, lines 1-67.

As per claims 43 and 80:

Downs further discloses:

wherein the at least one business rule specifies a provider to be used to deliver the media content offering to the selected group of consumers. Col. 72, lines 5-45.

As per claims 44 and 81:

Downs further discloses:

wherein the at least one business rule includes a price for association with at least one of the media assets in the media content offering. Col. 45, lines 29-65.

As per claims 45 and 82:

Downs further discloses:

wherein the at least one business rule includes-a time frame during which one or more of the media assets are available for access by the selected group of consumers. Col. 81, lines 3-56.

As per claim 46:

Downs further discloses:

wherein said content database is adapted to store a plurality of media content offerings to form a composite media content offering. Col. 11, lines 1-29.

As per claims 69 and 85:

Downs further discloses:

receiving the request for the media content offering by one of the consumers and delivering the selected media content offering over at least one of a DSL, satellite network, cable network, and wireless network. Col. 6, lines 49-55.

As per claims 72 and 87:

Downs does not expressly show wherein said step of refreshing is based at least in part on the demographics of members of each selected group of consumers. However, Downs does disclose directly tracking customer buying patterns. Col. 75, lines 37-40.

These differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The refreshing of the data on each of the selected group of consumers steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ

401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to refresh data on each of the selected groups with any type of data relating to the customers because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 73:

Downs does not expressly show wherein said step of refreshing is based at least in part on the viewing habits of members of each selected group of consumers. However, Downs does disclose directly tracking customer buying patterns. Col. 75, lines 37-40.

These differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The refreshing of the data on each of the selected group of consumers steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to refresh data on each of the selected groups with any

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type of data relating to the customers because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 571-272-6707. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel L. Greene
Examiner
Art Unit 3621

Daniel L. Greene
PRIMARY EXAMINER

10/17/2005